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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,226	11/03/2003	David William Froesel	7371	3104

7590 08/07/2008  
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EXAMINER
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CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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08/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/700,226  
Filing Date: November 03, 2003  
Appellant(s): FROESEL, DAVID WILLIAM

Paul M. Denk, # 22,598  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 27 May 2008 appealing from the Office action mailed 22 August 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: there are two bases, not one basis, of rejection.

Whether claims 3, 5, 6, 8 and 12-14 are unpatentable under 35 USC 103 over Geror (USPN 5,882,010) and Blume (USPN 4,392,653).

Whether claims 9-11 are unpatentable under 35 USC 103 over Geror, Blume and Bour (USPN 5,909,877).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,882,010	GEROR	03-1999
4,392,653	BLUME, SR.	07-1983
5,909,877	BOUR	06-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3, 5, 6, 8 and 12-14 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Geror in view of Blume.

Regarding claims 3, 5, 6 and 14, Figures 1-3 of Geror shows the recited integrally molded square box with base 20, sidewalls 18 and upstanding sleeve 14. Figures 1-3 also show the sleeve having an upper opening inherently capable of accommodating the insertion and removal of a metal paint can. Although Geror does not disclose the use of a metal paint can, it would have been obvious to one of ordinary skill in the art to place an insertable container within the upstanding sleeve of Geror in view of Blume in order to alter the difficulty of the game. See Figures 1-5 and column 2, lines 20-43 of Blume. To the extent that Blume fails to disclose the specific material used of his insertable member 32, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make it from metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Moreover, the Blume insert is considered to be inherently capable of being used as a paint can.

Regarding claim 8, Figure 3 of Geror best shows the double formed walls.

Regarding claim 12, Geror discloses the use of a pair of boxes spaced about 30 feet apart. Such a distance is considered to be approximately 25 feet apart. See column 3, lines 1-3.

Regarding claim 13, the size of the sleeve opening clearly affects the chance of a successful toss. Discovering an optimum value for a result-effective variable has been held to be within the capabilities of the person having ordinary skill in the art. As such, it would have been obvious to a person of ordinary skill, by routine experimentation, to modify the diameter of the Geror sleeve to be greater than five inches to vary the difficulty of the game. Further, containers are well-known in the art to have diameters greater than five inches and are inherently capable of being insert into the modified Geror sleeve.

Claims 9-11 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Geror and Blume in view of Bour.

Regarding claim 9, it would have been obvious to one of ordinary skill in the art to provide reinforcement ribs beneath the Geror box in view of Bour in order to make the target lightweight, yet rigid. See Bour at column 3, line 53 through column 4, line 14.

Regarding claims 10 and 11, Geror discloses apertures 36 near the base corners to secure the box to the ground. See Figure 2 and column 2, lines 34-40.

#### **(10) Response to Argument**

Appellant argues that Blume does not describe anything with respect to the audible aspects of the game, how certain components may be made of metal, and other part of plastic or wood, in order to provide for the distinction, when playing the game, so that the bulls-eye can be heard by everyone, to add to its excitement (Brief, page 8, last paragraph). However, it has been well-established that it is not necessary that the prior art suggest the combination to achieve the

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same advantage or result discovered by applicant. To select features from the prior art to effect results expected from these features is within the purview of 35 USC 103. The mere substitution of materials to construct game elements based on the suitability for the intended use (weight, rigidity, durability, etc.) is clearly within the capabilities of one skilled in the art.

Appellant also argues that the specific material used provides a greatly enhanced result. However, no evidence of such a result has been provided. One of ordinary skill in the art would certainly realize that different materials would produce different sounds when struck and appellant has failed to produce any evidence that any unexpected results would, in fact, result.

Appellant also argues that Geror is devoid of any reinforcement and that he does not show any means for accepting a nail or other securing device (Brief, page 9, last paragraph). However, such arguments are not directed to the aspects on which reliance is made. It is noted here that the claim limitation regarding the reinforcement has been addressed with Bour above. A case of non-obviousness cannot be made by attacking references individually where the rejection is based on a combination of references. Further, the Geror apertures are inherently capable of accommodating a nail.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Raleigh W. Chiu/  
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Conferees:

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714